THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ERNEST D. STILES

Appeal No. 96-3501
Application No. 08/172,773[1]

ON BRIEF

Before JOHN D. SMITH, HANLON and SPIEGEL, Administrative Patent Judges.

JOHN D. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal pursuant to 35 U.S.C. § 134 from the examiner's final rejection of claims 1 and 2, all the claims remaining in this application.

Claim 1 is representative and is reproduced below:

1. A method of making a plastic fuel tank having an integrally molded heat shield comprising:

[1] Application for patent filed December 27, 1993.

placing said heat shield against the interior surface of a mold, said heat shield having an insulating layer contacting said interior mold surface and a polyolefin foam pad having a heat fusible surface;

extruding a hot pliable parison within said mold;

inflating said parison and causing said parison to contact said heat fusible surface of said pad; and

raising and lowering the pressure within said parison wherein said parison and said fusible surface of said pad intermingle and fuse.

As evidence of obviousness, the examiner relies on the following references:

Giese et al. (Giese)		4,617,077	Oct. 14, 1986
Ufer et al. (Ufer)		4,830,810	May 16, 1989
Ohashi et al. (Ohashi)	Kokai	59-81221	May 10, 1984

The appealed claims stand rejected under 35 U.S.C. § 103 as unpatentable over Ohashi in view of Ufer or Giese.

The subject matter on appeal is directed to a method of integrally molding a plastic fuel tank with a heat shield having, inter alia, a polyolefin foam pad having a heat fusible surface. In appellant's method, the heat shield is placed within the interior of an open blow-molding tool wherein a plastic parison is extruded and inflated to cause the parison to contact the heat fusible surface of the

polyolefin foam pad. Importantly, the pressure within the parison is raised and lowered to cause the parison and heat fusible surface of the foam pad to intermingle and fuse when "the pad and parison are made from the same material" (specification, page 3, lines 14-16). This is said to insure a secure attachment of the fuel tank to the heat shield (brief, page 2).

As evidence of obviousness of the claimed method, the examiner relies on the disclosures in Ohashi, Geise, and Ufer. That Ohashi discloses a method of making a plastic fuel tank substantially identical to that claimed with the exception of the pressure raising and lowering step is not disputed by appellant.[2] Appellant contends, however, that none of the references teach "increasing and decreasing the pressure within the parison to aid in intermingling the foam and parison interfacial surfaces (emphasis added)." See the brief at page 4, lines 1-4. Appellant acknowledges that Giese and Ufer teach pressure changes to promote fluorination of a blow

[2] Appellant's brief contains no specific arguments or analysis of Ohashi, nor any arguments that the references have been improperly combined.

molded container, but appellants emphasize the changing the pressure during a fluorination step "is not at all suggestive of the welding action currently claimed." See the brief at page 4, lines 21 and 22.

Based on the disclosure in Giese at column 4, lines 3-28, it may be somewhat speculative to argue, as the examiner has in the answer at page 6, that increasing and decreasing the pressure during the conventional fluorination step would inherently lead to "some degree of enhanced intermingling as claimed." The examiner's broader finding, however, that Giese and Ufer show that "pressurization/depressurization steps" are "conventional in enhancing the blow molding of thermoplastic articles" (answer, page 4) is factually supported in Geise at column 7, line 52 to column 8, line 17 which indicates that plastic components to be mounted to the inner surface of a blow molded hollow body may be welded "in the course" of raising the pressure to a value of about 6 bars (column 7, lines 62 and 63) and that the pressure may then be reduced at a time when the blow molded body "has not yet hardened or which is only partially hardened" (column 8, lines 13 and 14). These teachings, in our view, are suggestive of

"the welding action currently claimed"[3]. A similar teaching is found in Ufer at column 2, lines 60 and 61 and Figure 2 which illustrates a preferred pressure sequence for a prior art blow molding operation.

Although appellant argues that the claimed method results in an enhanced attachment strength of the weld between the pad and parison (brief, page 3), no objective evidence is of record demonstrating that a weld strength produced by the claimed method differs at all from the weld strengths produced by the prior art processes.

In view of the above, we affirm the rejections of the appealed claims under 35 U.S.C. § 103. However, because we have relied on portions of the prior art references not specifically referred to in the answer as factual support for the obviousness conclusion, we denominate our affirmance as involving a new rejection under 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of

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[3] No claim on appeal is limited to "alternatingly" raising and lowering the pressure to form a type of "pulsing" as described in the specification at page 7, lines 1-6.

rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "a new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

> (b) Appellant may file a single request for rehearing within two months from the date of the original decision . . . .

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of

Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for reconsideration thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED; 37 CFR § 1.196(b)

JOHN D. SMITH Administrative Patent Judge	)
ADRIENE LEPIANE HANLON Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
CAROL A. SPIEGEL Administrative Patent Judge	)

jrg

Damian Porcari
Ford Motor Company
Parklane Towers East
Suite 911, One Parklane Boulevard
Dearborn, MI 48126